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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/386,605	08/31/1999	CHRISTOPHER G. TAYLOR	38-21-(15757	1594

73905 7590 10/18/2007  
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EXAMINER
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PAGE, BRENT T

ART UNIT	PAPER NUMBER
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1638

MAIL DATE	DELIVERY MODE
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10/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/386,605

Applicant(s)

TAYLOR ET AL.

Examiner

Brent Page

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 8-26 is/are pending in the application.
- 4a) Of the above claim(s) 12-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 8-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

The reply filed by Applicants 07/27/2007 is hereby acknowledged. All rejections of record not addressed below are considered hereby withdrawn in response to Applicants' claim amendments when taken together with Applicants' arguments. Claims 1 and 8-26 are pending with claims 12-26 currently withdrawn. Claims 1 and 8-11 are examined on the merits.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 8-11 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Trulson et al (EP 0262972 A2 published April 6, 1988), in view of Simpson et al (1986 Plant Mol. Biol. Vol. 6 pages 403-415) and further in view of Savka et al (1990 Phytopathology 80:503-508) for the reasons set forth in the previous office actions of record as well as those set forth below.

Applicant's arguments filed 07/27/2007 have been fully considered but they are not persuasive.

Applicants urge primarily that Trulson et al Do Not Teach the Formation of Chimeric plants.

This is not persuasive because as stated in previous office actions, Trulson et al do, in fact, teach the formation of chimeric plants. As stated previously, but more to the

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point, the fact that roots formed at all is evidence of the presence in the roots of *Agrobacterium rhizogenes* and therefore the formation of transgenic root tissue. However, the results show that out of 11 plantlets regenerated only 2 were NPT-positive, indicating that 9 out of 11 plantlets did not contain the selectable marker in the plantlets in sufficient quantity to be NPT positive. Therefore, Trulson teaches transgenic root tissue with non-transgenic shoots. One of ordinary skill in the art would appreciate that transformation methods commonly produce chimeric plants and commonly produce transformed tissue and non-transformed tissue, particularly where cut tissue is inoculated with *Agrobacterium*. Applicants do not specifically claim that ALL root tissue is transgenic, nor that ALL shoot tissue is wild type, only that transgenic root tissue and wild type leaves and shoots are present in the final product. Absent evidence to the contrary, the method taught by Trulson et al anticipates the claimed invention in that roots are generated from cut hypocotyls tissue by the inoculation of *Agrobacterium rhizogenes*. The aim of the currently claimed invention and the aim of Trulson et al is not material to the method steps.

Applicants further urge that Simpson et al and Savka et al do not cure the deficiencies of Trulson et al.

This is not persuasive because both Savka and Simpson specifically teach the transformation of soybean with *Agrobacterium rhizogenes* and that the formation of roots is most effective in soybean when using *Agrobacterium rhizogenes*. Therefore, it would have

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been obvious to one of ordinary skill in the art to apply the method taught by Trulson et al to soybean as suggested by Savka et al.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brent Page whose telephone number is (571)-272-5914. The examiner can normally be reached on Monday-Friday 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571)-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brent T Page

RUSSELL P. KALLIS, PH.D.  
PRIMARY EXAMINER

